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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,130	01/07/2002	Clifford A. Pickover	YOR920010296US1	2408
28062	7590	05/19/2005		
BUCKLEY, MASCHOFF, TALWALKAR LLC 5 ELM STREET NEW CANAAN, CT 06840			EXAMINER LANEAU, RONALD	
			ART UNIT 3627	PAPER NUMBER

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/041,130

Applicant(s)

PICKOVER ET AL.

Examiner

Ronald Laneau

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 21 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Response to Amendment***

1. The amendment filed on 03/31/05 has been entered. Claims 1-52 remain pending.

***Claim Rejections - 35 USC § 112***

2. The rejection under 35 USC § 112, first paragraph is withdrawn.

***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 24 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claim 1 only recites an abstract idea. The recited steps of merely associating an item with the shopping cart in response to a selection of the item by the consumer

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and by an entity other than the consumer does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. These steps only constitute an idea of how to do an online shopping cart.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces an online shopping cart (i.e., repeatable) used in selecting an item by the consumer and by an entity other than the consumer (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 24 and 25 are deemed to be directed to non-statutory subject matter.

The limitation "online shopping cart is either functional descriptive material (data per se) or non-functional descriptive material (data on a medium). Both cases are considered to be non-statutory. As a result, claims 24 and 25 must be canceled.

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-11, 13-19, 21, 23-41 and 43-51 are rejected under 35 U.S.C. 102(e) as being anticipated by McAuliffe (US 2003/0004798).

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As per claims 1-11, 13-17, 23-41 and 43-51, McAuliffe discloses a method for online shopping (electronic commerce), including the steps of: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); consumer selects the items to place in the shopping cart and consumer is associated to the shopping cart); and associating an item with the online shopping cart (page 3, [0024], lines 8-12); items are stored in the shopping cart and are therefore associated to the shopping cart), wherein the associated item was not selected by the consumer for association with the shopping cart (page 1, [0007], lines 10-13; the system provides consumer with an opportunity to buy additional items that were not selected with an enticement). McAuliffe further discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13); a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart Page 1, [0008], lines 14-16), wherein the item is complementary to the first item (page 1, [0007], lines 11-13); wherein the item is a substitute for the first item (page 1, [0007], lines 14-17); comprising: determining to associate the item with the online shopping cart based on a characteristic of items previously associated with the shopping cart (page 1, [0007], lines 14-17); wherein the characteristic comprises at least a type of one or more of the items (page 3, [0029], lines 6-8); including the step of determining to associate the item with the online shopping cart based on a characteristic (behavior) of the consumer (page 3, [0029], lines 9-10); wherein the characteristic comprises at least one shopping history (page 4, [0038], lines 11-14); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price

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of the item being offered for sale i.e. less than a retail cost). McAuliffe does not disclose a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed. Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, entitlement is altered to disassociate the second item from the shopping cart); comprising: presenting terms (financing term) for purchasing the item to the consumer (page 3, [0029], lines 16-19); further comprising determining the association based on rules (page 2, [0012], lines 3-7); comprising: dynamically updating the rules (page 3, [0025], lines 18-20); further comprising: notifying the consumer that the item was associated with the shopping cart (page 5, [0041], lines 8-14);

As per claim 18, 19 and 21, McAuliffe discloses a method for online shopping (electronic commerce), comprising: associating an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associating an item with the online shopping cart (page 3, [0024], lines 8-12) in response to a selection of the item by an entity other than the consumer (page 1, [0007], lines 10-13; entity = merchant = seller); wherein the entity is a potential seller (merchant) of the item (potential seller = merchant); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost). Furthermore, McAuliffe discloses a method further comprising: receiving an instruction from the consumer to disassociate a second item from the shopping cart; and in response to the instruction, automatically disassociating the

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item from the shopping cart (page 1, [0009], lines 3-12; upon consumer's return of item, enticement is altered to disassociate the second item from the shopping cart).

As per claims 43-51, McAuliffe discloses an apparatus for electronic shopping (electronic commerce), comprising: a processor (fig. 2, engine 210); and a storage device in communication with the processor and storing instructions adapted to be executed by the processor (page 3, [0027], lines 6-10) to: associate an online shopping cart with a consumer (page 11, [0007], lines 1-8); and associate an item with the online shopping cart (page 3, [0024], lines 8-12), wherein the associated item was not selected by the consumer for association with the shopping cart (page 1, [0007], lines 10-13; the system provides consumer with an opportunity to buy additional items that were not selected with an enticement). McAuliffe further discloses a method wherein the item is associated with the shopping cart based on at least one of: a shopping history of the consumer (page 4, [0038], lines 10-13); a method further comprising: determining to associate the item with the online shopping cart based on a first item associated with the shopping cart (page 1, [0008], lines 14-16), wherein the item is complementary to the first item (page 1, [0007], lines 11-13); wherein the item is a substitute for the first item (page 1, [0007], lines 14-17); wherein a cost of the associated item is less than a retail cost that would be charged to the consumer for the item if the item was selected by the consumer for association with the shopping cart (page 3, [0025], lines 11-13; merchants determine the price of the item being offered for sale i.e. less than a retail cost); wherein the entity is a potential seller of the item (potential seller = merchant). McAuliffe does not disclose a charge for associating an item into the shopping cart for consumers to purchase i.e. the cost of the associated item must be free as claimed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 12 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAuliffe (US 2003/0004798).

As per claims 12 and 22, McAuliffe does not disclose does not disclose that a method wherein an item cannot be disassociated from the shopping cart but it is obvious for McAuliffe's system to prevent an item from being removed from the shopping card once associated therein because it would allow a user of the system to make a decision on whether or not to purchase the supplemental item at the time of checkout.

5. Claims 20, 42 and 52 are rejected under 35 U.S.C. 103(a) as being unpatentable over McAuliffe (US 2003/0004798) in view of Batachia et al (US 2002/0116349).

As per claims 20, 42 and 52, McAuliffe does disclose an intelligent buyer agent 290 in fig. 2) but does not disclose a merchant or an entity other than the consumer using an intelligent agent but Batachia is used to show that the concept of utilizing an intelligent between the consumers and the merchants is old and well known in the art.

It would have been obvious to one of ordinary skill in the art to utilize the intelligent agent as taught by Batachia into the system of McAuliffe because it would improve the

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negotiation capability between consumers and merchants and also enable to operate reliably, efficiently and profitably on behalf of their clients (merchants or consumers).

### ***Response to Arguments***

6. Applicant's arguments filed on 03/21/05 have been fully considered but they are not persuasive.

Applicant argues that the enticements are associated with items in the shopping cart and not associated with the shopping cart itself. Contrary to applicant's arguments, the items offered in the enticement are complementary items for users to purchase and the items that Applicant associates with the shopping cart are also complementary items to items selected by a user. I think that it is a form of enticement to users to purchase items being offered or provided in the shopping cart. The end result is for customers to purchase through a transaction the additional or complementary items offered or provided for purchase in the shopping cart. Applicant's arguments are deemed unpersuasive, claims 1-52 remain rejected.

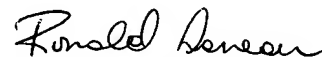
### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald Laneau whose telephone number is (703) 305-3973. The examiner can normally be reached on Mon-Fri from 8:30am - 6:00pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ronald Laneau  
Examiner  
Art Unit 3627

5/16/05

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